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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/469,637	12/22/99	MOSES	M CMZ-083CPCN

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HM12/1121

EXAMINER

GITOMER, R

ART UNIT

PAPER NUMBER

1623

DATE MAILED:

11/21/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No.  
**09/469,637**

Applicant(s)  
**Moses et al.**

Examiner  
**Ralph Gitomer**

Group Art Unit  
**1623**



☒ Responsive to communication(s) filed on Dec 22, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

☒ Claim(s) 1-121 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-121 are subject to restriction or election requirement.

### Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Restriction to one of the following inventions is required  
under 35 U.S.C. 121:

- 5 I. Claims 1-34, 47, 48, 50-55, 64-103, drawn to a method  
for facilitating a diagnosis, classified in class 435,  
subclass 6.
- II. Claims 35-46, 49, 104-114, drawn to a method for  
facilitating the prognosis of prostate disorders,  
classified in class 435, subclass 6.
- 10 III. Claims 56-63, 115-121, drawn to a kit for facilitating  
diagnosis, classified in class 435, subclass 975.

The inventions are distinct, each from the other because:

15 Inventions I and II are related as subcombinations disclosed  
as usable together in a single combination. The subcombinations  
are distinct from each other if they are shown to be separately  
usable. In the instant case, invention II has separate utility  
such as being employed by people who already have a diagnosis.  
See MPEP § 806.05(d).

20

Inventions I and II vs. III are related as process and  
apparatus for its practice. The inventions are distinct if it  
can be shown that either: (1) the process as claimed can be  
practiced by another materially different apparatus or by hand,  
25 or (2) the apparatus as claimed can be used to practice another

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and materially different process. (MPEP § 806.05(e)). In this case the method could be practiced by hand.

5 Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

10 Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

15 Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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This application contains claims directed to the following patentably distinct species of the claimed invention: Applicants are required to elect a single condition and a single enzyme each of which is specific, substantial and credible.

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claims are generic.

5 Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic  
10 is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37  
15 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or  
20 identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of  
25 the other invention.

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Any inquiry concerning this communication or earlier  
communications from the examiner should be directed to Ralph  
Gitomer whose telephone number is (703) 308-0732. The examiner  
can normally be reached on Tuesday-Friday from 8:00 am - 5:00 pm.  
5 The examiner can also be reached on alternate Mondays. If  
attempts to reach the examiner by telephone are unsuccessful, the  
examiner's supervisor, Gary Geist can be reached on (703) 308-  
1701. The fax phone number for this Art Unit is (703) 308-4556.  
Any inquiry of a general nature or relating to the status of this  
10 application should be directed to the Group receptionist whose  
telephone number is (703) 308-1234. For 24 hour access to patent  
application information 7 days per week, or for filing  
applications electronically, please visit our website at  
www.uspto.gov and click on the button Patent Electronic Business  
15 Center for more information.

*Ralph Gitomer*  
Ralph Gitomer  
Primary Examiner  
Group 1623

RALPH GITOMER  
PRIMARY EXAMINER  
GROUP 1200